

REMARKS

This paper is in response to the Office Action mailed January 14, 2005.

Claims 2-3, 6-10 and 16-22 have been amended. Claims 11-13 have been canceled herein, whereas claims 14-15 were previously canceled. Claims 23 and 24 are new claims. After entry of this amendment, claims 1-10 and 16-24 are pending in this patent application. Support for the amendments is found in the present application at least at pages 35-44. No new matter has been added.

Rejection Under 35 USC 102(b)

Claims 1, 4, 5 and 17 were rejected as being anticipated by the white paper "TCO Analyst." This rejection is traversed because TCO Analyst does not disclose the claimed invention.

Claim 1 recites that the appraisal metric is assigned to an information technology organizational function category, and reporting the appraisal metrics associated only with the specific category selected. This feature is neither disclosed nor suggested by the cited references.

First, on page 6 of the Office Action, the Examiner has admitted the absence of this step of reporting only metrics associated with a selected category by stating with regard to claim 6 that "TCO Analyst does not explicitly teach reporting the appraisal metrics and cost information in separate reports for corresponding organizational functional categories." While the reference teaches that the TCO estimates may be customized, there is no specific teaching present that the customization is "necessarily"

limited to reporting only metrics associated with selected categories. Therefore, this feature is not inherently present in the reference.

Second, while the reference may disclose associating costs with organizational categories, it does not disclose assigning determined metrics with those categories. The TCO Analyst reference in Figure 5 on page 8 lists a model TCO Chart of Account proposed by the Gartner Group. This Gartner Group model proposes four main categories of information technology functions, each with multiple sub-categories. However, the reference teaches at the bottom of page 8 that the Interpose Chart of Accounts shown on Figure 6, page 9 is preferred. So despite the fact that the TCO Analyst lists multiple sub-categories of cost data and associating the cost data with the categories, it fails to suggest associating the determined appraisal metrics with the categories of service management, systems management, service planning and change management, as recited by claim 1.

Accordingly, claim 1 is not anticipated by the cited reference and the rejection should be withdrawn. Claims 2-5 and 17-21 and new claim 23 are dependent on Claim 1 and, therefore, are also allowable for the reasons noted above with regard to Claim 1.

Claims 17 further recites that the method further comprises “identifying interrelationship profiles between the financial perspective metrics and related operational effectiveness and efficiency metrics and related infrastructure and evolution perspective metrics.” This feature is not disclosed in the TCO Analyst. Therefore, for this additional reason, the rejection against claim 17 should be withdrawn.

Rejection Under 35 USC 103(a)

Claims 2, 3, 6-16 and 18-22 were rejected as being obvious over the white paper “TCO Analyst.” This rejection is traversed or has been overcome by the above amendments to the claims..

Claims 2 and 3 have been amended to recite that the specific recited costs are used by the computer to determine the appraisal metrics. Contrary to the assertion in the rejection, the recited costs are now not non-functional descriptive material and are functionally involved in the step. Therefore, these limitations must be considered in distinguishing the references. As the examiner has admitted these recited costs are not taught in the cited reference, the rejection should be withdrawn as to these claims.

Claim 6 has been amended to overcome the rejection. First, Claim 6 recites “defining interrelationship profiles between the financial perspective metrics and related operational effectiveness and efficiency metrics and related infrastructure and evolution perspective metrics.” The cited reference does not teach or suggest identifying the interrelationship profiles between the different categories of appraisal metrics.

Second, while the reference may disclose associating costs with organizational categories, it does not disclose assigning determined metrics with those categories. The TCO Analyst reference in Figure 5 on page 8 lists a model TCO Chart of Account proposed by the Gartner Group. This Gartner Group model proposes four main categories of information technology functions, each with multiple sub-categories. However, the reference teaches at the bottom of

page 8 that the Interpose Chart of Accounts shown on Figure 6, page 9 is preferred. So despite the fact that the TCO Analyst lists multiple sub-categories of cost data and associating the cost data with the categories, it fails to suggest associating the determined appraisal metrics with the categories of service management, systems management, service planning and change management, as recited by claim 1. Accordingly, claim 6 is not obvious over the TCO Analyst.

Claims 7-10, 22 and 24 are dependent on claim 6. For the same reasons as noted above for claim 6, these dependent claims are also allowable over the cited reference, and the rejection should be withdrawn.

Claims 8-9 have been amended to recite that the specific recited costs are used by the computer to determine the appraisal metrics. Contrary to the assertion in the rejection, the recited costs are now not non-functional descriptive material and are functionally involved in the step. Therefore, these limitations must be considered in distinguishing the references. As the examiner has admitted these recited costs are not taught in the cited reference, the rejection should be withdrawn as to these claims.

Claims 18-22 have been amended to recite further steps of the method operating on the recited certain of the appraisal metrics. Contrary to the assertion in the rejection, the recited costs are now not non-functional descriptive material and are functionally involved in the step. Therefore, these limitations must be considered in distinguishing the references, and the rejection withdrawn as the TCO Analyst does not describe comparing these specific non-financial metrics with benchmarks or metrics determined in prior periods.

New Claims

Claims 23 and 24 are presented new with this amendment. These claims recite identifying a relationship in said interrelationship profile as a complementary relationship, a trade-off relationship or an influential relationship. This feature is neither taught nor suggested by the TCO Analyst reference. Therefore, these claims are allowable.

CONCLUSION

Applicants respectfully submit that the pending claims are in form for allowance in view of the amendments for the reasons noted above. Should the Examiner feel a discussion would expedite the prosecution of this application, the Examiner is kindly invited to contact the undersigned.

Respectfully submitted,



Marc V. Richards
Registration No. 37,921
Attorney for Applicant(s)

BRINKS HOFER GILSON & LIONE
P.O. Box 10395
Chicago, IL 60610
(312) 321-4200